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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,956	06/01/2001	Jian J Lu	PM-275378	4522

909 7590 01/30/2003

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EXAMINER

NICKOL, GARY B

ART UNIT	PAPER NUMBER
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1642

14

DATE MAILED: 01/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/733,956

Applicant(s)

LU ET AL.

Examiner

Gary B. Nickol Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 7-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Response to Amendment***

The Amendment filed November 12, 2002 (Paper No. 13) in response to the Office Action of May 7, 2002 is acknowledged and has been entered.

Claims 10-13 were added.

Claims 1-13 are pending.

Claims 7-9 have been withdrawn from further consideration by the examiner under 37 CFR 1.142(b) as being drawn to non-elected inventions.

Claims 1-6, 10-13 are pending and are currently under consideration.

**The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.**

**Rejections Maintained:**

Claims 1-6 remain rejected and new claims 10-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Deen *et al.* (US Patent No. 6,013,476, April 2, 1997) for the reasons of record in Paper No. 10, pages 6-7, and for the reasons set forth below.

Applicant's argue (Paper No. 13, pages 8-9) that Deen *et al.* fail to anticipate the claimed invention as the reference does not teach or suggest that the claimed protein induces apoptosis. Applicants have pointed out that the MPEP and the Courts have established a high threshold for rejecting claims based on characteristics which are allegedly inherently present in a prior art reference. Applicants have further recited the case law from the MPEP 2112 which includes *In re*

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*Rijckaert, In Re Oelrich, and In re Robertson*. These arguments have been considered but are not found persuasive. With regards to the case law, the facts of the present application do not parallel the decisions made in the latter cases. Furthermore, applicant has not provided sufficient reasoning which compares the facts and decisions from the individual cases to the presently claimed subject matter.

To summarize, Deen *et al.* teaches an isolated polypeptide comprising an amino acid sequence which is 655 amino acids long (column 2, bottom of page) referred to as TR7 (column 2, line 55). Deen *et al.* further teach fragments of TR7 which encompass amino acid portions of TR7 including from about amino acid 1-20, 21-40, 41-60, 61-80, etc. (column 6, lines 5+). The polypeptide of Deen *et al.* comprises, has, or consists essentially of 100% sequence similarity to applicant's full-length polypeptide, including amino acids 168-240. Thus, the exact structural and compositional information claimed by applicant is taught in the prior art. Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the **same** as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under 35 U.S.C. 102 (MPEP 2112). Thus, even though the reference does not characterize the polypeptide as being capable of inducing apoptosis, such a functional property is merely suggestive of an intended use and is not given weight for purposes of comparing the claims with the prior art. The claims read on the product *per se*, polypeptides; and products of identical chemical composition can not have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, since the prior art teaches the identical chemical structure, the properties applicant discloses and/or

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claims are necessarily present. Thus, applicant's arguments have not been found persuasive and the rejection is maintained.

**All other rejections and or objections are withdrawn in view of applicant's amendments and arguments there to.**

No claim is allowed.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary B. Nickol Ph.D. whose telephone number is 703-305-7143. The examiner can normally be reached on M-F, 8:30-5:00 P.M..


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Gary B. Nickol Ph.D.  
Examiner  
Art Unit 1642

GN  
January 16, 2003

  
ANTHONY C. CAPUTA  
SUPERVISORY  
TECHNOLOGY  
JAN 16 2003